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Address: COMMISSIONER OF PATENTS AND TRADEMARKS Washington, DC 20231

APPLICATION NO

FIRST NAMED INVENTOR

ATTORNEY DOCKET NO.

09/976,063

11/21/97

2128080844

STEINBUCHEL

BAYER-9998-C

HM11/0807

SPRUNG KRAMER SCHAEFER & BRISCOE 660 WHITE PLAINS ROAD 4TH FLOOR

TARRYTOWN NY 10591-5144

TUNG, P

ART UNIT PAPER NUMBER

EXAMINER

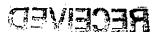
1652

DATE MAILED:

/08/07/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



AME 12 1998

Application No.	Α¢

	08/978,063	Steinbuche	et al.
Office Action Summary	Examiner Peter Tung	Group Art Unit 1652	
Responsive to communication(s) filed on			<u> </u>
This action is FINAL .			
Since this application is in condition for allowance in accordance with the practice under Ex parte Qu	ayle, 1935 C.D. 11; 453 O.S	i. 213.	
A shortened statutory period for response to this actions longer, from the mailing date of this communication application to become abandoned. (35 U.S.C. § 133) 87 CFR 1.136(a).	i. Failure to respond within /i	he pariod for response	Will cause the
Disposition of Claims	JUPY		
		_ is/are pending in the	application.
Of the above, claim(s) 10-13		Is/are withdrawn from	consideration.
☐ Claim(s)			
☑ Claim(s) <u>1-9</u>			
Claim(s)		is/are objected	to.
☐ Claims			
 ☐ The drawing(s) filed on is ☐ The proposed drawing correction, filed on ☐ The specification is objected to by the Examine ☐ The oath or declaration is objected to by the Examine ☐ Priority under 35 U.S.C. § 119 	is ⊡appro r. caminer.	oved Edisapproved.	
 ☒ Acknowledgement is made of a claim for foreign ☒ All ☐ Some* ☐ None of the CERTIFIED ☒ received. ☐ received in Application No. (Series Code. ☐ received In this national stage application *Certified copies not received: ☐ Acknowledgement is made of a claim for dome 	O copies of the priority docur	nents have been nu (PCT Rule 17.2(a)).	·
	Stie priority and a diara-		
Attachment(s) Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449 Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Reviet Notice of Informal Patent Application, PTO-152	w, PT 0-948		
SEE OFFICE AC	TION ON THE FOLLOWING PA	GES	

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2128080844

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reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

In the specification on pages 17, 19 and 20, sequences greater than 10 nucleotides or 4 4. amino acids are disclosed. These sequences need to comply with the sequence rules as stated above.

Election/Restriction

- 5. Claims 1 and 8 are generic to a plurality of disclosed patentably distinct species comprising coniferyl alcohol, coniferylaldehyde, ferulic acid, vanillin and vanillic acid. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.
- Claim 2 is generic to a plurality of disclosed patentably distinct species comprising 6. eugenol hydroxylase, coniferyl alcohol dehydrogenase, coniferylaldehyde dehydrogenase, ferulic acid deacylase and vanillin dehydrogenase. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.
- 7. If coniferyl alcohol and eugenol hydroxylase are elected, claim 9 will be included with claims 1-8 readable on the elected species.

If coniferylaldehyde and coniferyl alcohol dehydrogenase are elected, claim 10 will be included with claims 1-8 readable on the elected species.

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If ferulic acid and coniferylaldehyde dehydrogenase are elected, claim 11 will be included with claims 1-8 readable on the elected species.

If vanillin and ferulic acid deacylase are elected, claim 12 will be included with claims 1-8 readable on the elected species.

If vanillic acid and vanillin dehydrogenase are elected, claim 13 will be included with claims 1-8 readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

- 8. During a telephone conversation with Ms. Carmella O'Gorman on 7/20/98 a provisional election of species was made with traverse to prosecute the invention readable on the elected species coniferyl alcohol and eugenol hydroxylase, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
- 9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any